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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,110	03/16/2001	Ryuichi Matsukura	1405.1038	8919

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2171

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DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/809,110

Applicant(s)

MATSUKURA ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on amendment of 2/9/04 and RCE of 3/3/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Action is responsive to Applicant's RCE request filed on March 3, 2004 and amendment submitted on February 9, 2004 (paper # 7 and 9).

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2004 has been entered.

Claims 1-22 remain for examination, in addition, claim 23 is presented for examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Handel et al.

(U.S. Patent No. 6,195,651).

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Regarding claims 1, 2, 5, 7, 8, 14, 22 and 23, Handel discloses a product information system and method comprising (fig. 10A, 1020 and 1070):

additional information management means (fig. 10A, 1020) for associating (col. 30, line 44, *link*) an individual product of a product information database (fig. 10A, 1050, *product list*, col. 30, line 45) with additional information classified based upon predetermined user profile information, in additional information database (fig. 10A, 1060);

(Note: via integrator 1020 and supplier's server 1070 the database 1050 links databases 1030, 1040, 1050 and 1060 with supplier databases 1080; see col. 30, lines 43-45)

product information presentation means for presenting basic information for the individual product to a user from the product information database (fig. 10A, 1050 and 1010);

profile information acquisition means (fig. 10A, item 1020) for acquiring profile information (fig. 10A, 1060) of the user (fig. 10A, 1010) wishing to look up basic information for the individual product (fig. 10A, items 1050 and 1080);

(Note: database 1050 partially acquires basic product information via server 1070)

display parameters *processing* means (fig. 10A, 1020, 1050 and 1070) for selecting from the additional information database (fig. 10A, **1080** and 1040), the additional information corresponding to the acquired user according to the predetermined user profile classification of the additional information of the presented individual product (fig. 10A, 1060); and,

additional information presentation means for presenting to said user (fig. 10A, 1010) for the presented individual product, the selected additional information (fig. 10A, 1040 and 1080, see also associated text).

(Note: for example, the additional information may be product rating and price)

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Regarding claims 3, 4, 6 and 9, Handel discloses the profile information acquisition means conducts wireless communication with a user terminal storing that user's profile information to acquire the user's profile information (fig. 17, items 1710, 1730 and 1750).

(Note: identification of a user is inherent from a user profile)

Regarding claim 10, Handel discloses a product information management server manages a profile database (fig. 10A, 1060 and 1020, and col. 34, lines 35-38).

(Note: merchants trying to provide a service to the user further imply they manage the profile)

Regarding claim 11, Handel teaches a customer management server (fig 10A, 1020) interconnected with said product information server (fig. 10A, 1070) manages a profile database (fig. 10A, 1060, and col. 34, lines 35-38).

(Note: the profile gateway server receives all requests for profile information from the user himself)

Regarding claims 12 and 13, Handel discloses product information server (fig. 10A, 1070) manages said additional information database (fig. 10A, 1040).

(Note: server 1070 manages 1040 along with server 1020)

Regarding claims 15-19, Handel discloses a java applet for displaying information, accepting text input (col. 8, lines 35-61), and managing text messages (fig. 11, items 1111-1122).

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(Note: for more detail also see agents on col. 35 lines 38-61)

Regarding claims 20 and 21, Handel discloses an order procedure accepting product orders from user terminal (fig. 10A, items 1090 and 1010).

### ***Response to Arguments***

Applicant's arguments filed on February 9, 2004 and RCE of March 3, 2004 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on pages 10-12 of the 2/9/2004 response, that Handel does not teach an additional database which stores additional information for individual products, wherein the additional information is classified according to predetermined user profile parameters.

In response to Applicant's argument, the Examiner disagrees. It appears that the Applicant's have misunderstood the Handel system. Referring to fig. 10A, Handel discloses a customer (1010) acquiring basic information from a supplier (1070 and 1080) while a server (1020) uses the customer's profile (1060) along with the supplier's product information (1070 and 1080) and existing information (1040 and 1050) to select information for the customer consisting of additional information for the desired products (1040 *product ratings*, and 1080, *price and features of each product*) based on the supplier and customer profile databases (1050 and 1060) along with integrator's web server and supplier's web server (1020 and 1070). The

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user parameters are stored in the customer profile database comprising personal preferences and history (col. 30, line 50).

Applicant argues on pages 11 and 12 of the 2/9/2004 response, that none of the Handel databases in fig. 10A provide the present invention's association of basic information of each product with additional information that is classified according to predetermined user profile parameters, as shown in fig. 4.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., fig. 4) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note, Handel discloses a content database (fig. 10A, 1040) which stores all of the information related to the intention comprising personalized content and product ratings (col. 30, lines 37-40). Further, customer profile database 1060 is part of the intentions (col. 30, lines 27-31). Hence, database 1040 is the additional information database (see rejection).

Examiner makes note of the pertinent prior art cited on 5/13/2003 which further discloses user profiles in marketing systems.

With respect to all the pending claims 1-23, Examiner respectfully traverses Applicant's assertion based on the discussion cited above.

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***Conclusion***

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112, objections and amendments) that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156.


The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF

March 26, 2004

  
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